

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

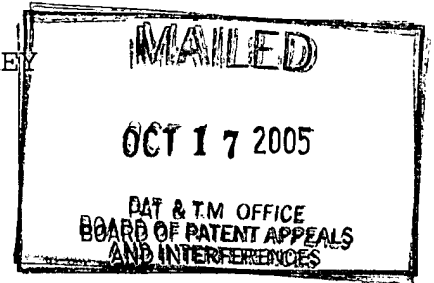
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARL J. EVENS, JOAN HARKEY
and RALPH S. HOEFELMEYER

Appeal No. 2005-2677
Application No. 09/304,787

ON BRIEF



Before THOMAS, RUGGIERO, and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-7 and 13-28. Claims 8-12 have been canceled.

We affirm.

BACKGROUND

Appellants' invention is directed to a method for directed marketing wherein unique identification numbers for paging service subscribers are generated. Each time a message is sent to the pager, one or more advertisements are attached to the actual

Appeal No. 2005-2677
Application No. 09/304,787

message intended for the paging service subscribers who have the unique identification numbers. An understanding of the invention can be derived from a reading of exemplary independent claim 1, which is reproduced as follows:

1. A method of messaging, comprising:
generating a capcode associated with an advertisement script;
and
attaching the advertisement script to a message for a paging service subscriber associated with the capcode.

The Examiner relies on the following references:

| | | |
|----------------------------------|-----------|--|
| Fascenda et al. (Fascenda) | 5,241,305 | Aug. 31, 1993 |
| Lewis et al. (Lewis) | 5,594,945 | Jan. 14, 1997 |
| Dimitriadis et al. (Dimitriadis) | 5,664,948 | Sep. 9, 1997 |
| DeLuca et al. (DeLuca) | 5,870,030 | Feb. 9, 1999 |
| Taubenheim et al. (Taubenheim) | 6,060,997 | May 9, 2000 (filed Oct. 27, 1997) |
| Yeh et al. (Yeh) | 6,208,717 | Mar. 27, 2001 (filed Feb. 23, 1998) |

Claims 1, 4, 5, 7, 13, 14, 16-22 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Taubenheim and Fascenda.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Taubenheim, Fascenda and Lewis.

Claims 3 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Taubenheim, Fascenda and DeLuca.

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Taubenheim and Yeh.

Appeal No. 2005-2677
Application No. 09/304,787

Claims 23-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Taubenheim, Fascenda and Dimitriadis.

Rather than reiterate the opposing arguments, reference is made to the briefs and answer for the respective positions of Appellants and the Examiner. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the briefs have not been considered (37 CFR § 41.37(c)(1)(vii)).

OPINION

At the outset, we note that Appellants indicate that all the claims stand or fall together with claim 1 being the representative claim (brief, page 3). We therefore, limit our review to the representative claim 1 and address the claim rejections as they relate to different grounds of rejection.

Appellants argue that although the prior art teaches using capcodes and attaching advertisement script to a message for a paging service subscriber associated with the capcode, there is no association between an advertisement script and a capcode (brief, pages 4-6). Additionally, Appellants assert that the claims require the capcode, not only for association with a specific pager, but also for association with an advertisement script (brief, page 6).

Appeal No. 2005-2677
Application No. 09/304,787

In response to Appellants' arguments, the Examiner points out that Appellants have not challenged Taubenheim's teaching of transmitting advertisement scripts to pagers or sending advertisements using capcodes (answer, page 6). The Examiner further reasons that, as outlined by Appellants (specification, pages 6-7), since the capcode is a standard feature of paging systems used to identify the paging subscribers, a corresponding capcode must be generated and be associated with any message sent to the pager (id.).

Before addressing the Examiner's rejections based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. The claim construction analysis begins with the words of the claim. See Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582, 39 USPQ2d, 1573, 1576 (Fed. Cir. 1996). Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985). Accordingly, we will initially direct our attention to Appellants' claim 1 to derive an understanding of the scope and content thereof.

Claim 1 is directed to a method of messaging wherein a capcode associated with an advertisement script is generated, which in

Appeal No. 2005-2677
Application No. 09/304,787

turn, is attached to a message for a paging subscriber associated with the capcode. Although Appellants argue that the claimed invention first generates the capcode to not only identify the pager, but also to identify an association with an advertisement script (reply brief, page 3), claim 1 does not preclude using the capcode generated for the subscriber as the capcode to be associated with the advertisement script. Additionally, the claim requires "attaching" the advertisement script to a message for a paging subscriber "associated" with the same capcode. Therefore, as asserted by the Examiner (answer, page 6), the alleged distinctions made by Appellants with respect to generating the capcode to add information to a prior art pager ID, beyond associating the pager capcode with the advertisement script, are not recited limitations in the claims.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would

have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

We agree with the Examiner that Taubenheim (col. 9, lines 9-12) suggests using capcodes in coding as the reference describes formatting the information to be sent to the subscribers into frames or segments which include the control data (col. 8, lines 57-63). Taubenheim specifically mentions receiving each segment or frame which contains the address encoded therein "[i]f the frame is capcode assigned" (col. 9, lines 9-12) while each frame is encoded with the information and the control data (col. 9, lines 12-13).

Fascenda, on the other hand, teaches that a capcode assigned to each pager also identifies, among all the broadcast messages from a central transmitter, the message intended for that particular pager (col. 1, lines 15-25). Fascenda also states:

Each message is intended for a particular pager and has that pager's capcode associated with the message.
(Col. 1, lines 20-22.)

Therefore, contrary to Appellants' argument that the prior art merely associates the capcode (that identifies only the unique physical pager) with the message and advertisement script by combining these three elements, the capcode is associated with the message. Furthermore, Taubenheim provides for including such

Appeal No. 2005-2677
Application No. 09/304,787

identification in the control data in each frame of the broadcast information.

Based on the findings above, we remain unconvinced by Appellants that the prior art capcode only identifies the pager whereas the claim requires generating the capcode to not only identify the pager, but also an association with an advertisement script (brief, page 6; reply brief, pages 2-3). In that regard, we find that the same capcode that is associated with the pager in Fascenda is also associated with the message for identification purposes. Thus, we find the Examiner's reliance on Fascenda for showing that the capcode is also associated with the pager in combination with Taubenheim to be reasonable and sufficient to support a prima facie case of obviousness and sustain the 35 U.S.C. § 103 rejection of the representative claim 1, as well as claims 4, 5, 7, 13, 14, 16-22 and 28, grouped together with claim 1 over Taubenheim and Fascenda.

The decision of the examiner to reject claim 2 over Taubenheim, Fascenda and Lewis, claims 3 and 6 over Taubenheim, Fascenda and DeLuca, claim 15 over Taubenheim and Yeh and claims 23-27 Taubenheim, Fascenda and Dimitriadis under 35 U.S.C. § 103 is also sustained since Appellants have not challenged these rejections with any reasonable specificity, thereby allowing the

Appeal No. 2005-2677
Application No. 09/304,787

claims to fall with claim 1 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

CONCLUSION

In view of the foregoing the decision of the Examiner rejecting claims 1-7 and 13-28 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

JAMES D. THOMAS
Administrative Patent Judge

Joseph J. Ruggiero
JOSEPH J. RUGGIERO
Administrative Patent Judge

Mahshid D. Saadat
MAHSHID D. SAADAT
Administrative Patent Judge

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Appeal No. 2005-2677
Application No. 09/304,787

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